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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/463,474	08/04/00	SINN H	8484-077-999

HM22/1114

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EXAMINER	
LUKTON, D	
ART UNIT	**PAPER NUMBER**
1653	6

DATE MAILED: 11/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/463,474	Sinn
Examiner	**Group Art Unit**
David Lukton	1653

☒ Responsive to communication(s) filed on *Aug 4, 2000*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *one* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-10 and 12-17* is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-10 and 12-17* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☑ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Pursuant to the directives of paper No. 5 (filed 8/4/00), claims 1-10 have been amended, claim 11 has been cancelled, and claims 12-17 added.

Claims 1-10, 12-17 are pending.

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A restriction is imposed, as set forth below. First, however, the following two subgenera are defined:

G1: the carrier can be whatever the claims permit, including a protein, provided that polyethers are excluded.

G2: the carrier can be whatever the claims permit, including a polyether, provided that proteins are excluded.

Restriction is required under 35 U.S.C. §121 and 372. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. It is the assertion of the examiner that literature on fluorescent conjugates of proteins (and other molecules) is extensive, and that while perhaps claim 17 is novel, the remaining claims are not; the claimed invention does not "define a contribution" over the prior art. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted. Restriction to one of the following inventions is required :

I. Claims 1, 2, 4-10, 12, 13, 15, 16, drawn to conjugates which are limited to G1.

II. Claims 1, 3-10, 14-16, drawn to conjugates which are limited to G2.

III. Claim 17, drawn to a method of distinguishing unhealthy tissue from healthy tissue.

The claimed inventions are distinct.

Groups I and II are distinguished on the basis of the carrier. Proteins and polyethers have different structures, different *in vivo* interactions, different classifications, and different searches are required.

Inventions {I, II} and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). The compounds of Groups I and II have many diagnostic uses, not limited to the method of claim 17. Nevertheless, in the event that applicants elect either of Groups I and II, and claims therein found allowable, the corresponding method-of use claim(s) will be rejoined [*In re Ochiai* (**37** USPQ2d 1127)].

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The "specie" is a fully defined molecule. Every atom in the molecule must be accounted for, i.e., it is not merely sufficient to list a specific fluorescent compound, a specific connector, and a specific carrier. The manner in which they are bonded together must also be specified. Applicants should also specify the approximate excitation wavelength (e.g., 320-450 or 630-850 nm).

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are witten in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. □103 of the other invention.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

DAVID LUKTON
PATENT EXAMINER
GROUP 1800